

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN R. REILLY

Appeal No. 2000-0187
Application 08/430,943

ON BRIEF

Before HAIRSTON, RUGGIERO and LEVY, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-21, which are all of the claims pending in the present application.

The claimed invention relates to a remote computer display for a portable computing device (PCD) in which a wireless transmitter built into the PCD sends graphic commands to the remote display. In order to reduce the data link bandwidth

required to transfer images from the PCD to the remote display, graphic primitives are sent over the data link. The graphic primitives are generated by a video driver in the PCD which converts video display requests issued by a software program executing on the PCD. A wireless receiver connected to the remote display converts the received signals into digital data representing the graphic primitives which produces a graphic image on the remote display.

Claim 1 is illustrative of the invention and reads as follows:

1. A remote computer display system comprising:

a portable computing device (PCD) having a wireless transmitter;

a remote video display electrically connected to a wireless receiver;

the PCD also having a video driver operative to receive video requests issued by a software program executing on the PCD and converting the video requests into graphics primitives which are sent as signals by the wireless transmitter to the wireless receiver;

the wireless receiver being operative to receive the signals sent by the wireless transmitter and to convert the received signals into digital data representing the graphics primitives and also operative to send the digital data to a remote display driver;
and

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the remote display driver is operative to cause the remote video display to display a video image in response to the digital data sent by the wireless receiver.

The Examiner relies on the following prior art references:¹

Folger et al. (Folger)	5,337,044	Aug. 09, 1994
Gaskill et al. (Gaskill)	5,440,559	Aug. 08, 1995
		(filed Nov. 10, 1993)

Carleton et al. (Carleton)	EP 0616448	Sep. 21, 1994
(Published European Patent Application)		

Claims 1-21 stand finally rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner offers Appellant's admitted prior art in view of Carleton with respect to claims 1-4, 9-12, 17, 20, and 21, adds Folger to the basic combination with respect to claims 5, 6, 13, 14, 18, and 19, and adds Gaskill to the basic combination with respect to claims 7, 8, 15, and 16.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs² and Answer for the respective details.

¹ In addition, the Examiner relies on Appellant's admissions as to the prior art appearing in the "Background of the Invention" beginning at page 1, line 7 of the specification.

² The Appeal Brief was filed August 25, 1997 (Paper No. 11). In response to the Examiner's Answer dated November 25, 1997, (Paper No. 12), a Reply Brief was filed December 15, 1997 (Paper No. 13), which was acknowledged and entered by the Examiner in the communication dated December 13, 2001 (Paper No. 15).

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OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, the arguments in support of the rejection and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Brief along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-21. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1,

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17-18, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins &Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to independent claims 1, 9, 17, and 20, the Examiner, as the basis for the obviousness rejection, proposes to modify the disclosure appearing in the "Background of the Invention" section of the instant application, which the Examiner

has interpreted as being admitted prior art. According to the Examiner (Answer, pages 5-7), this "Background" section, which describes techniques for connecting video displays with larger dimensions to a portable computing device (PCD), discloses the claimed invention except that graphic information in the form of a bitmap is transmitted to a video display, rather than the transmission of graphic primitives as claimed. To address this deficiency, the Examiner turns to the Carleton reference which, in the Examiner's view, describes the transfer of graphic data in the form of high level instructions which treat image information as objects such as rectangles, which the Examiner has likened to the claimed "graphic primitives." In the Examiner's line of reasoning (id. at 15), the skilled artisan would have been motivated and found it obvious "... to transfer graphic primitives instead of bitmaps from the PCD to the remote display in order to reduce the bandwidth required to transfer display [sic] the information to a remote computer display by a wireless link."

In response, Appellant contends that the Examiner has failed to set forth a prima facie case of obviousness since proper

motivation for the proposed combination of the admitted prior art and Carleton has not been established. In support of this position, Appellant asserts (Brief, pages 21-23) that the Examiner has erred in interpreting the extent of what is admitted prior art appearing in the "Background" section at pages 1-3 of the specification.

In Appellant's view, the admitted prior art is limited to the known cabling and docking techniques for connecting a portable computing device (PCD) with a remote video display discussed at page 1, line 17 through page 2, line 5 of the specification. Appellant further contends that the suggestion of a wireless link, the recognition of graphical data transmission problems associated with a wireless connection, and a solution to overcome such problems (specification, page 2, line 6 through page 3, line 3) is a result of Appellant's own work, not any admission of existence in the prior art.

After careful review of the statements in Appellant's specification and the Carleton reference, in light of the arguments of record, we are in agreement with Appellant's position as stated in the Briefs. We find no basis for the

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Examiner's conclusion that Appellant's discussion of wireless links and the recognition of problems with increased bandwidth in transmitting graphical information over a wireless link is part of the admitted prior art. To the contrary, we find that the statements in the specification alleged to be admissions of prior art by the Examiner, are in fact Appellant's own analysis of problems existing in the prior art and a solution to such problems. These statements, as alluded to by Appellant (Brief, page 22, are in compliance with suggestions for inclusion in the "Background of the Invention" portion of a patent application appearing at section 608.01(c)(2) of the Manual of Patent Examining Procedure (MPEP).

In view of the above discussion, we find that the Examiner has provided no prior art disclosure of connecting a portable computing device (PCD) with a remote video display over a wireless link, nor any recognition of a need for reduced bandwidth transmission of graphical information over such wireless link. In our opinion, any attempt to combine the teaching of Carleton, which is directed to the connection of

separate computer systems over a wired telephone line, could not come from any suggestion in the prior art but, rather, only from Appellant's own disclosure.³

We have also reviewed the disclosures of the Folger and Gaskill references applied by the Examiner to address the recitations of the housing structure of the wireless transmitters and receivers, respectively, of several dependent claims. We find nothing, however, in either of these references that would overcome the innate deficiencies of the teachings of the admitted prior art and Carleton discussed supra. Accordingly, since the Examiner has not established a prima facie case of obviousness, the rejection of independent claims 1, 9, 17, and 20, as well as claims 2-8, 10-16, 18, 19, and 21 dependent thereon, is not sustained.

³ Since we find that the Examiner has failed to establish a prima facie case of obviousness based on the proposed combination of the admitted prior art and Carleton, the issue of whether Carleton does in fact disclose the generation of graphic primitives using a video driver is moot.

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In summary, we have not sustained the Examiner's 35 U.S.C.
§ 103 of any of the claims on appeal. Therefore, the decision of
the Examiner rejecting claims 1-21 is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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STUART S. LEVY)	
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